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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,317	10/20/2000	Kia Silverbrook	ART85US	8404
24011	7590	07/11/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,317	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	King Y. Poon	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 6/26/2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton et al (US 6,304,345) and Patton et al (US 6,894,794) in view of Mui (US 6,160,642).

Regarding claim 6: Patton 345 teaches an apparatus (fig. 3) for reproducing an a visible image (12 fig. 1) depicted in a photograph (fig. 1, column 1, lines 10-15), the photograph also carrying digitally encoded data printed (14, fig. 1), the apparatus comprising: a scanner means (column 4, lines 1-3) for scanning the digital data; means for illuminating the photograph with radiation (inherent properties of scanning, all scanner must have light illuminating the photograph, also see column 8, lines 5-10); means (the device that decodes the code of column 5, lines 5-15 that is used for

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reprinting image 12) for processing data output from the scanner means, the means for processing data including means for decoding the digitally encoded data scanned by the scanner means; and, inkjet printer means (column 4, lines 45-50, 47, fig. 3) for receiving data from the means for processing (e.g., 39, fig. 3) data to print the visible image depicted in the photograph (12, fig. 1, column 5, lines 5-15); wherein the data used to print the visible image is generated using the digitally encoded data (code 16, column 5, lines 1-5).

Patton 345 does not teach the digitally encoded data are printed with invisible ink.

However, Patton 794, teaches it is desirable to improve Patton 345 by printing the digitally encoded data with invisible ink (column 1, lines 29-39, 09/211,232 is Patton 345 which is incorporated by reference; column 3, lines 15-25).

Patton does not disclose an ADF for advancing the photograph.

However, Mui in the same area of scanning photograph (column 3, lines 43-45), teaches it is well known in the art to provide an ADF for advancing print media (column 1, lines 60-66).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Patton to include: an ADF for advancing the photograph.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Patton by the teaching of Mui because it would have saved users a lot of effort of advancing the photograph manually.

Regarding claim 3: Patton 794 teaches wherein the invisible ink is an infra-red absorbing ink (column 3, lines 15-20), and wherein the invisible radiation is infra-red light (column 4, lines 60-67, column 5, lines 1-3).

Regarding claim 4: Patton teaches wherein the inkjet printer means includes means for printing out on a print media attached to the inkjet printer means both the visible image depicted in the photograph and the digitally encoded data (column 1, lines 54-58 794 teaches code 16 and image 12 are printed at same time; the examiner view the print means that print the code 16 and image 12 are the inkjet printer means.

4. Claims 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton et al (US 6,304,345) and Patton et al (US 6,894,794) in view of Mui (US 6,160,642) as applied to claim 6 above, and further in view of Zhang (US 5,771,245).

In accordance with claims 2 and 5, Patton does not disclose expressly that the digitally encoded data is encoded and decoded using the Reed-Solomon process.

Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4 lines 18-20).

Patton and Zhang are combinable because they are from the same field of endeavor, namely two-dimensional data encoding and decoding.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the encoding/decoding process in Patton's system.

The motivation for doing so would have been that the Reed-Solomon process is a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

Response to Arguments

5. Applicant's arguments with respect to claims 2-6 have been considered but are moot in view of the new ground(s) of rejection.

Please see detailed office action.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 2, 2006



KING Y. POON
PRIMARY EXAMINER